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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/015,868

12/12/2001

Michael D. Hooven

HOOV 117

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01/11/2008

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD  
SUITE 2850  
200 WEST ADAMS STREET  
CHICAGO, IL 60606

EXAMINER

CHEN, VICTORIA W

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

01/11/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/015,868

Applicant(s)

HOOVEN, MICHAEL D.

Examiner

Victoria W. Chen

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 50,54-58 and 67-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50,54-58 and 67-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/25/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 50, 54, 56-58 and 67-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Paraschac (US H1745).**

Regarding claim 50, Paraschac discloses an ablation apparatus comprising first [116] and second [117] jaw assemblies [Fig. 5], the jaw assemblies being movable between open and closed positions, each jaw assembly having a clamping surface [Fig. 5] with a width and an elongated electrically conductive member [147, 148], the conductive members in face to face relation and connectible to a bipolar energy power source [col. 7, ll. 5-9] so as to be of opposite polarity, the conductive members each having a tissue contacting portion [118, 119] which has a width less than the width of the clamping surface of its associated jaw assembly [Fig. 5], each jaw assembly including an internal jaw support member [147, 148, Fig. 5] and an insulative cover [134, 164, 146, 156] that surrounds the internal jaw support member [Fig. 5].

Regarding claim 54, the tissue contacting portion widths disclosed by Paraschac [widths of elements labeled 119 and 118 in Fig. 5] can be seen to be less than or equal to about one-third of the width of the associated clamping surface [inner surfaces of 116 and 117, Fig. 5].

Regarding claim 56, Paraschac discloses the conductive member is generally centrally located relative to the clamping surface [Fig. 5].

Regarding claim 57, both conductive members define an interior lumen [120, 121].

Regarding claim 58, Paraschac discloses a portion of the clamping surface is disposed on each side of the conductive member [Fig. 5].

Regarding claim 67, it is inherent that each jaw assembly includes an opening disposed for receiving a respective conductive member therein, since there is a conductive member within each jaw assembly.

Regarding claims 68 and 73, it is inherent that each insulative cover includes an opening disposed for receiving a conductive member therein since each insulative cover [e.g. 146 and 134 for jaw assembly 116] surrounds its respective conductive member [147]. The opening can also be interpreted as a groove.

Regarding claim 69, Paraschac discloses each insulative cover is located on each side of the respective elongated conductive member and forms the clamping surface [e.g. Fig. 5, insulative cover part 134 forms part of clamping surface of jaw 116].

Regarding claim 70, the jaw support members as disclosed by Paraschac can be reinterpreted as half of each previous jaw support member [i.e. jaw support member 147 of jaw 116 can be reinterpreted as half of 147 and the other half of 147 to be two jaw support members].

Regarding claim 71, Paraschac discloses each elongated conductive member protrudes through an opening in the respective insulative cover [Fig. 5].

Regarding claim 72, Parachac discloses each elongated conductive member is substantially flush with the respective clamping surface [Fig. 5, e.g. 118 is flush with 134].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac.**

Regarding claim 55, Paraschac teaches the claimed invention except for the specific length and width of the conductive members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the length and width of the conductive members since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

***Response to Arguments***

Applicant's arguments with respect to claims 50-58 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's argument that Paraschac does not disclose an internal jaw support member surrounded by an insulated cover, the examiner considers the insulated covers [134, 164, 146, 156] to surround internal jaw support members [147, 148]. There is no claim language which necessitates the complete enclosure of the internal jaw support member by the insulated cover, and applicant himself acknowledges that the internal jaw support member is surrounded, albeit partially, by an insulative cover [Applicant's remarks, pg. 7, ll. 19-23].

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victoria W. Chen whose telephone number is (571) 272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/015,868  
Art Unit: 3739

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VWC/  
1/7/08



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
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